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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057941
Party	Defendant Barnaby Heating & Air
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Submission	Opposition/Response to Motion
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Date	09/08/2015
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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3,618,331

Registration Date: May 12, 2009

Mark: COMFORTCLUB

Clockwork IP, LLC

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Petitioner

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v.

)

Cancellation No. 92057941

)

Barnaby Heating & Air, LLC

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)

Respondent.

)

**RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION TO
STRIKE THE SUPPLEMENTAL AFFIDAVIT OF CHARLES BARNABY**

COMES NOW Respondent, Barnaby Heating & Air, LLC, by and through its undersigned counsel, and files this Opposition to Petitioner's Motion to Strike the Supplemental Affidavit of Charles Barnaby, and states as follows:

Respondent asks that prior to a ruling on the pending summary judgment motions, that the Board deny Petitioner's motion to strike and that the Board give full consideration to what the facts in this case reveal, versus what Petitioner attempts to conceal. Petitioner served discovery

on Respondent after the close of discovery in this case. While that “litigation” tactic, and the corresponding Trademark Rule, might be authorized by the written letter of the Trademark Manual Board of Practice, or the Board, such a practice is clearly not intended to reveal the truth. In keeping with that same modus operandi, Petitioner now seeks to strike truthful testimony and relevant documentary evidence – **documentary evidence that came from the files of Petitioner’s subsidiary** – in this case, by claiming Respondent intentionally violated the rules.

Respondent only recently discovered the expired licensing agreement in its files, which agreement existed for a short period of time for a portion of 2007 between AirTime 500, a subsidiary of Petitioner’s, and Respondent. Had Respondent located the documents sooner, it would have gladly turned those materials over to Petitioner. However, Petitioner has always had access to these materials and for Petitioner to allege that it is prejudiced by the clear and convincing written testimony of Mr. Charles Barnaby, and by documents to which it has always had access, is a farce. Given Petitioner’s complete failure to uphold and abide by the contract between the parties in this case, and Petitioner’s late-service of discovery after the close of the discovery period in this case, Respondent would expect nothing more from Petitioner.

Following the receipt of Petitioner’s Motion for Summary Judgment, Respondent filed the affidavit of Charles Barnaby, and accompanying exhibits, in support of Respondent’s Opposition to Petitioner’s summary judgment motion, and in support of Respondent’s Cross-Motion for Summary Judgment on Respondent’s affirmative defenses of contract estoppel and failure to state a claim, *et al.* The supplemental affidavit of Charles Barnaby, and the documentary evidence in support thereof, was filed in support of Respondent’s Reply to its Cross-Motion for Summary

Judgment, and was timely filed prior to the time set for Respondent to respond. Because Petitioner is unable to contradict the clear and convincing written testimony of Mr. Barnaby, and because the documentary evidence attached in support thereof is not only relevant, but damning to the Petitioner's claims and defenses, Petitioner moves to strike Mr. Barnaby's written testimony, and Petitioner attempts strike and conceal relevant documentary evidence – **documentary evidence that originated from Petitioner's subsidiary**. Respondent asks that the Board deny Petitioner's motion to strike, because it is an obvious and desperate attempt by Petitioner to exclude relevant evidence in this case.

MEMORANDUM

Respondent's reply brief in support of its cross-motion for summary judgment was filed timely and the supplemental affidavit of Charles Barnaby is authorized by the rules. Trademark Board of Manual of Procedure § 528.05(a)(1) and Federal Rule of Civil Procedure 43(e) permits a motion for summary judgment to be heard on affidavits. Federal Rule of Civil Procedure 43(e) and the TMBP § 528.05(a)(1) state that when a motion is based on facts not appearing of record, the Board may hear the matter on affidavits. TMBP § 528.05(b) allows for the affidavits submitted in response, or in opposition to, a motion for summary judgment to be supplemented by depositions, answers to interrogatories, or further affidavits. An affidavit may be given consideration if the statements therein are clear and convincing in character and uncontradicted. *Id.*

Respondent admits the licensing agreement between Respondent and AirTime 500 was discovered in Respondent's files only recently. Because Petitioner is unable to contradict

Barnaby's accurate and truthful written testimony, and the damning contractual terms within its own documents, Petitioner next argues that Barnaby's affidavit contradicts statements Barnaby made in response to interrogatories served by Clockwork IP, LLC relating to licensing agreements with Clockwork IP, LLC; clearly it does not. The one-time license between Barnaby and AirTime 500 has long expired. Petitioner failed to serve an interrogatory on Respondent that explored the prior existence of, or the expiration of, any licensing agreements between Respondent and AirTime 500, LLC. Respondent's answer to Clockwork IP, LLC's written discovery requests were truthful and accurate. Importantly, the written testimony of Mr. Charles Barnaby remains uncontradicted and should be given full consideration by this Board in deciding the pending summary judgment motions.

The fact remains that this case is barred by the defense of contract estoppel. There exists a Contract between the parties in this case, wherein the parties agreed that any causes of action arising from, or relating to, the parties be filed and heard in the federal or state courts located within the State of Missouri. The Petitioner has failed to show how the affidavit submitted in support of Respondent's Reply to its Cross-Motion for Summary Judgment has prejudiced Petitioner. Petitioner would be hard-pressed to demonstrate any real prejudice given that the documents came from the files of Petitioner's subsidiary. Respondent therefore requests this Board accept all of the affidavits filed by Respondent and consider all of the documentary evidence submitted in this case.

WHEREFORE, Respondent respectfully requests this Board deny Petitioner's Motion to Strike so that this case can be decided on what the facts reveal, versus what they

conceal.

Barnaby Heating & Air, LLC

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION TO STRIKE** was filed on September 8, 2015 and forwarded to counsel for Petitioner and counsel for Co-Respondent, this 8th day of September 2015, by email and by sending the same via first class mail:

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